

REMARKS

In the Office Action, Claims 1-36 were examined and stand rejected. In response to the Office Action, Claims 1, 28 and 34 are amended, no claims are added and no claims are cancelled. Applicant respectfully requests reconsideration of pending Claims 1-36 in view of the following remarks.

I. Claims Rejected Under 35 U.S.C. §103

The Examiner has rejected Claims 1, 2, 4, 6-8, 11-26, 28-29 and 33-36 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,298,482 issued to Seidman et al. (“Seidman”) in view of U.S. Patent No. 6,298,482 in view of Brown (“Brown”). Applicant respectfully traverse this rejection.

Regarding Claims 1, 15 and 25, Claims 1, 15 and 25 recite analogous claim features. Claim 1 is representative. Claim 1 recites at least the following claim feature which is neither disclosed nor suggested by Seidman:

broadcasting, by the service provider system according to the ratings, at least one available for broadcast data file for selective storage within the one or more client systems according to respective content rating tables of the one or more client systems and prior to broadcast of at least one of the plurality of upcoming data files by the broadcast service system. (Emphasis added.)

Conversely, Seidman discloses a system for two-way digital multi-media broadcast and interactive services; specifically, as recited by Seidman:

The present invention enables the provision, to the user, of the capability to navigate through a large number of video (and other multi-media) resources in a unique fashion. The user can move within and between video sources without exiting the viewing of the video display. By selecting video objects (see above) within the current video, the viewer is given the ability to move to one or more alternative video sources. From that video, the same capability can move the user to another video source and so on. (col. 5, lines 24-32.) (Emphasis added.)

As further described by Seidman:

The digital stream which is transmitted on the downstream path is a multiplex of streams of various media, such as video and audio, and may contain multiple streams of each media type. (col. 4, lines 40-43.) (Emphasis added.)

As defined by Seidman:

A multiplex is a set of media streams which are coordinated for concurrent play, such as a video media stream and an audio media stream. (col. 5, lines 3-5.) (Emphasis added.)

Based on the cited passages above, Applicant respectfully submits that the disclosure of Seidman is limited to a single content provider that transmits a digital stream to a user which is a multiplex of streams that are coordinated for concurrent play (*See*, col. 5, lines 3-5) and the use of a set top box to enable the user to navigate through the concurrently transmitted video and audio streams of the multiplex received from the single content provider (*See*, col. 5, lines 24-32). As further described by Seidman, the digital stream may be customized according to selection history records generated from monitoring viewing of the user (see col. 6, lines 2-6 and col. 7, lines 5-19).

Applicant respectfully submits that the content provider in the viewer response system, as taught by Seidman, is a single content provider having various video and audio streams, which may be concurrently provided as a multiplex for navigation thereof by a user. (*See*, col. 5, lines 3-5.) Furthermore, Seidman explicitly requires the coordinated transmission of a multiplex of audio and video streams for concurrent play of the audio and video streams to enable a user to navigate the concurrently transmitted audio and video streams to select a combination thereof and receive a customized digital stream. (*See, supra.*)

As correctly recognized by the Examiner, Seidman fails to teach or suggest the broadcasting of at least one available for broadcast data file to the one or more client systems for selective storage therein according to respective content rating tables as the one or more client systems, and prior to the broadcast of at least one of the plurality of upcoming data files by the broadcast service system. (*See*, pg. 3, ¶4 of Office Action mailed January 31, 2006.) As a result, the Examiner cites Brown, which according to the Examiner, teaches the above-recited feature of amended Claims 1, 15 and 25. (*See, Brown*, col. 12, lines 25-35.)

According to the Examiner, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Seidman to record at least one TV program on the user receiver according to user profile, as taught by Brown, so the recorded program may be viewed at a later time. (*See*, pg. 4, first paragraph of Office Action mailed January 31, 2006.) Assuming, arguendo, that one would modify Seidman in view of Brown, as suggested by the Examiner, Applicant respectfully submits that such modification would still fail to teach or

suggest that the service provider broadcast of the at least one available for broadcast data file occurs prior to broadcast of at least one of the plurality of upcoming data files by the broadcast service system, as recited by Claims 1, 15 and 25.

As mandated by case law, “to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Here, the Examiner cites Brown to teach or suggest the broadcast of at least one available for broadcast data file for selective storage within one or more client systems according to a content rating table of the client system, and prior to the broadcast of an upcoming data file by the broadcast service system, as recited by Claims 1, 15 and 25. According to the Examiner, the above-recited feature is either taught or suggested by Brown at col. 12, lines 25-35. As indicated by such portion of Brown:

When the recording apparatus 100 detects that the television 101 is not switched on and displaying a program, the recording apparatus 100 utilizes received profile data to determine which received programs are associated with profile data strongly corresponding to the stored user profile indicative of programs which have been displayed by the television 101. Where the profile data of a received program corresponds strongly to the user profile stored within the recording apparatus 100 the recording apparatus 100 records that program in a memory, so that the recorded program may be viewed at a later date. (col. 12, lines 25-35.) (Emphasis added.)

As indicated by the cited passage above, the recording apparatus records a program in memory if the program corresponds strongly to a user profile. Applicant respectfully submits that such passage refers to the recording of received programs and hence, provides no teachings or suggestions with regard to the broadcasting of such programs. Furthermore, such passage fails to provide any teaching or suggestion that such recorded programs are broadcast prior to broadcast of an upcoming data files, as recited by Claims 1, 15 and 25.

Hence, Applicant respectfully submits that the prior art combination of Seidman in view of Brown fails to teach or suggest each and every feature recited by Claims 1, 15 and 25, as required to establish a *prima facie* case of obviousness. Id.

Furthermore, even assuming, arguendo, that the Examiner were to identify some teaching or suggestion within Brown regarding the broadcast of the at least one available for broadcast data file prior to broadcast of a plurality of upcoming data files, modification of Seidman to

include such functionality would render Seidman unsatisfactory for its intended purpose of enabling a user to navigate concurrently transmitted audio and video streams to select a combination thereof and receive a customized digital stream. (*See*, col. 4, lines 40-43 and col. 5, lines 3-5 and 24-32.)

As established by case law, “if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” In re Gordon, 733 F2d 900, 221 USPQ 1125 (Fed.Cir. 1984.)

Here, Applicant respectfully submits that one skilled in the art would not modify Seidman to broadcast an available for broadcast data file prior to the broadcast of an upcoming data file, as recited by Claims 1, 15 and 25, since Seidman explicitly requires the coordinated transmission of a multiplex of audio and video streams; namely, coordinated transmission is required to achieve the goal of concurrent play of the audio and video streams to enable a user to navigate the concurrently transmitted audio and video streams to select a combination thereof and receive a customized digital stream. (*See*, col. 5, lines 3-5 and 24-32.) Consequently, any modification of Seidman to broadcast an available for broadcast data file prior to the broadcast of an upcoming data files, as required to teach or suggest at least the above-recited feature of Claims 1, 15 and 25, would render Seidman unsatisfactory for its intended purpose of enabling a user to navigate concurrently transmitted audio and video streams to select a combination thereof and receive a customized digital stream. (*See*, col. 4, lines 40-43 and col. 5, lines 3-5 and 24-32.)

Therefore, the Examiner is prohibited from modifying Seidman to perform the broadcast of the least one available for broadcast data file prior to broadcast of the plurality of upcoming data files since such modification would render Seidman unsatisfactory for its intended purpose. In re Gordon, *supra*.

Consequently, for at least the reasons provided above, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness of Claims 1, 15 and 25, since the prior art combination of Seidman in view of Brown fails to teach or suggest each and every feature recited by Claims 1, 15 and 25, as required to establish a *prima facie* case of obviousness. In re Royka, *supra*.

Moreover, the Examiner is prohibited from modification of Seidman to perform the broadcast of at least one available for broadcast data file prior to the broadcast of a plurality of upcoming data files, since such modification would render Seidman unsatisfactory for its intended purpose of enabling a user to navigate concurrently transmitted audio and video streams to select a combination thereof and receive a customized digital stream. (See, Seidman, col. 4, lines 40-43 and col. 5, lines 3-5 and 24-32.) In re Gordon, supra.

Accordingly, for at least the reasons provided above, Applicant respectfully submits that Claims 1, 15 and 25 are patentable over the combination of Seidman, in view of Brown. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the §103(a) rejection of Claims 1, 15 and 25.

Regarding Claims 2 and 4, Claims 2 and 4, based on their dependency from Claim 1 and for at least the reasons provided above, are also patentable over the prior art combination of Seidman in view of Brown. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the §103(a) rejection of Claims 2 and 4.

Regarding Claims 16-18, Claims 16-18, based on their dependency from Claim 15, are also patentable over the combination of Seidman in view of Brown. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the §103(a) rejection of Claims 16-18.

Regarding Claims 26, 28 and 29, Claims 26, 28 and 29, based on their dependency from Claim 25, are also patentable over the prior art combination of Seidman in view of Brown. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the §103(a) rejection of Claims 26, 28 and 29.

Regarding Claims 6, 19 and 28, Claims 6, 19 and 28, recite analogous claim features. Claim 6 is representative. Claims 6, 19 and 28 recite the following claim feature which is neither taught nor suggested by the combination of Seidman in view of Brown:

receiving at least one of an upcoming data file broadcast by the service provider system and an available for broadcast data file broadcast by the broadcast service system; and

storing, based on the content rating table, one of the received available for broadcast data file broadcast by the broadcast service system and the received upcoming file broadcast by the service provider system. (Emphasis added.)

As recited by Claims 6, 19 and 28, the data files stored are a combination of data files available for broadcast from a service provider system and a plurality of upcoming data files that are to be broadcast by a broadcast service system. Conversely, Applicant respectfully submits that the disclosure of Seidman is limited to a single content provider that transmits a digital stream to a user which is a multiplex of streams that are coordinated for concurrent play (*See*, col. 5, lines 3-5).

Hence, Applicant respectfully submits that the content provider in the viewer response system, as taught by Seidman, is a single content provider having various video and audio streams, which may be concurrently provided as a multiplex for navigation thereof by a user. (*See*, col. 5, lines 3-5.) Consequently, the program segments provided to users, as taught by Seidman, are from a single service provider or a single broadcast service system for concurrent playback, and not from a combination thereof as recited by Claims 6, 19 and 28.

According to the Examiner, receiving an upcoming data file, broadcast by a service provider system, and an available for broadcast data file, broadcast by a broadcast service system, as recited by Claims 6, 19 and 28, is taught by Seidman at col. 5, lines 55-67, col. 8, lines 20-50, col. 9, lines 45-67 and col. 10, lines 1-6. (*See*, pp. 5 and 6, ¶4 of Office Action mailed January 31, 2006.) Applicant respectfully disagrees.

Applicant has carefully reviewed the cited passages indicated by the Examiner and although such passages provide reference to multiple groups of users (*see*, col. 3, lines 55-67), the multiplex of audio and video streams received by such users are provided from a single head end and hence, from a single content provider. (*See*, col. 3, lines 56-65.) Therefore, Seidman does not teach or suggest the receipt of audio and video streams from multiple content providers, as recited by Claims 6, 19 and 28, since Seidman is expressly limited to a single content provider, which has various audio and video streams, which may be concurrently provided as a multiplex for navigation thereof by a user. (*See*, col. 5, lines 3-5.)

Furthermore, the disclosure in Brown is also limited to a single content provider and not multiple content providers, such as a service provider system and a broadcast service system from which available for broadcast data files and upcoming data files are received, as recited by Claims 6, 19 and 28.

Accordingly, for at least the reasons provided above, Applicant respectfully submits that the prior art combination of Seidman in view of Brown fails to teach or suggest each of the above-recited features of Claims 6, 19 and 28, as required to establish a *prima facie* case of obviousness. In re Royka, supra.

Therefore, for at least reasons provided above, Applicant respectfully submits that Claims 6, 19 and 28 are patentable over the combination of Seidman in view of Brown. Id. Consequently, Applicant respectfully requests that the Examiner reconsider and withdraw the §103(a) rejection of Claims 6, 19 and 28.

Regarding Claims 7 and 11, based on there dependency from Claim 6, are also patentable over Seidman in view of Brown. Consequently, Applicant respectfully request that the Examiner reconsider and withdraw the § 103(a) rejection of Claims 7 and 11.

Regarding Claim 20, Claim 20 based on its dependency from Claim 19, is also patentable over Seidman in view of Brown, as well as the references of record. Consequently, Applicant respectfully requests that the Examiner reconsider and withdraw the § 103(a) rejection of Claim 20.

Regarding Claims 29 and 33, based on the dependency from Claim 28, are also patentable over Seidman in view of Brown, as well as the references of record. Consequently, Applicant respectfully requests that the Examiner reconsider and withdraw the § 103(a) rejection of Claims 29 and 33.

Regarding Claims 12 and 22, Claims 12 and 22 recite the following claim features, which are neither taught nor suggested by either the combination of Seidman in view of Brown or the references of record:

selectively receiving, based on the content rating table, a subset of the plurality of upcoming data files broadcast by the service provider system;
storing the subset of the plurality of available for broadcast data files broadcast by the service provider system; and
when a data file from the subset of the plurality of upcoming data files is broadcast based on the broadcast schedule, storing the upcoming data file based on the content rating table. (Emphasis added.)

For at least the reasons indicated above, the disclosure in Seidman is limited to the transmission of a digital stream on a downstream path, which is a multiplex of various media that is coordinated for concurrent play. (See, col. 4, lines 40-43 and col. 5, lines 3-5.) Hence, the

above-recited features of Claims 12 and 22 of delaying storage of data file from the plurality of upcoming data files until the data file is broadcast by the broadcast service system clearly indicates that the upcoming data files broadcast by the broadcast service system and the subset of the plurality of available for broadcast data files broadcast by the service provider system are not provided for concurrent play by a user.

Applicant respectfully submits that Seidman explicitly requires the transmission of a digital stream to a user must be coordinated for concurrent play. (*See, supra.*) Hence, Seidman, cannot teach or suggest the subsequent receipt of upcoming data files broadcast by a broadcast service system for storage within one or more client systems based on the content rating table, as recited by amended Claims 12 and 22. Accordingly, Applicant respectfully submits that the Examiner's citing of Brown fails to rectify the deficiencies of Seidman in failing to teach or suggest each of the above-recited features of Claims 12 and 22, as required to establish a *prima facie* case of obviousness. *In re Royka, supra.*

Hence, Applicant respectfully submits that the Examiner is prohibited from establishing a *prima facie* case of obvious of Claims 12 and 22, since the combination of Seidman in view of Brown fails to teach or suggest each of the recited features of amended Claims 12 and 22. *Id.*

Consequently, Applicant respectfully submits that amended Claims 12 and 22 are patentable over the combination of Seidman in view of Brown as well as the references of record. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the § 103 rejection of Claims 12 and 22.

Regarding Claims 13 and 14, Claims 13 and 14, based on their dependency from Claim 12, are also patentable over the combination of Seidman in view of Brown. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the § 103 rejection of Claims 13 and 14.

Regarding Claims 23 and 24, Claims 23 and 24, based on their dependency from Claim 22 and for at least the reasons described above, are also patentable over the combination of Seidman in view of Brown. Consequently, Applicant respectfully requests that the Examiner reconsider and withdraw the §103 rejection of Claims 23 and 24.

Regarding Claim 34, amended Claim 34 recites the following claim features which are neither disclosed nor suggested by the combination of Seidman in view of Brown:

wherein the service provider server selects at least one upcoming data file of the plurality of the upcoming data files according to the ratings received from the one or more client systems, and

wherein the service provider broadcast server further broadcasts the selected upcoming data file for selective storage within the one or more client system according to respective content rating tables of the one or more client systems and prior to broadcast of the selected data file by the broadcast service system. (Emphasis added.)

For at least the reasons indicated above, the combination of Seidman in view of Brown, is devoid of any disclosure regarding the broadcast, by a service provider system, of an upcoming data file prior to broadcast of the upcoming data file by a broadcast service system and for selective storage within one of our client systems as recited by Claim 34. Conversely, Seidman teaches that the concurrent transmission program segments are part of the multiplexed digital stream from a single service provider that is coordinated for concurrent play to enable a user to select segments to form a customized segment stream. (*See*, col. 5, lines 24-32.)

Hence, Applicant respectfully submits that the Examiner fails to establish a *prima facie* case of obviousness of Claim 34, since the prior art references of Seidman in view of Brown fail to teach or suggest each and every element recited by Claim 34 and required to establish a *prima facie* case of obviousness. In re Royka, *supra*.

Therefore, Claim 34 is patentable over Seidman in view of Brown, as well as the references of record. Consequently, Applicant respectfully requests that the Examiner reconsider and withdraw the § 103(a) rejection of Claim 34.

Regarding Claims 35 and 36 are based on their dependency from 34 are also patentable over Seidman in view of Brown, as well as the references of record. Consequently, Applicant respectfully requests that the Examiner reconsider and withdraw the § 103(a) rejection of Claims 35 and 36.

The Examiner has rejected Claim 3 under 35 U.S.C. §103(a) as being unpatentable over Seidman in view of Brown and further in view of U.S. Patent No. 6,601,237 issued to Ten Kate et al. ("Ten Kate"). Applicant respectfully traverses this rejection.

Regarding the Examiner's citing of Ten Kate, even assuming, arguendo, that Ten Kate taught the non-concurrent transmission of video and audio streams, the Examiner would be prohibited from modifying Seidman in view of such teaching within Ten Kate, assuming such

teaching existed, since such modification would render Seidman unsatisfactory for its intended purpose of providing a coordinated transmission of a multiplex of audio and video streams for concurrent play of the audio and video streams to enable a user to navigate the concurrently transmitted audio and video streams to select a combination thereof and receive the customized digital stream. (See, Seidman, col. 4, lines 40-43, col. 5, lines 3-5 and 24-32.) In re Gordon, supra.

Accordingly, for at least the reasons provided above, Applicant respectfully submits that Claim 1 is patentable over the combination of Seidman in view of Brown and further in view of Ten Kate.

Consequently, for at least the reasons provided above, Claim 3, based on its dependency from Claim 1, is also patentable over the combination of Seidman in view of Brown and further in view of Ten Kate. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the §103(a) rejection of Claim 3.

The Examiner has rejected Claim 5 under 35 U.S.C. §103(a) as being unpatentable over Seidman and in view of Brown and further in view of U.S. Patent Application No. 2002/0112235 to Ballou, Jr. et al. ("Ballou"). Applicant respectfully traverses this rejection.

For at least the reasons indicated above with regard to the §103(a) rejection of Claim 3, the Examiner is prohibited from citing any reference, which teaches the modification of Seidman for performing the non-concurrent transmission of audio and video streams, as would be required to render Claim 1 unpatentable. Accordingly, for at least the reasons provided above, Applicant respectfully submits that Claim 1 is patentable over the combination of Seidman in view of Brown and further in view of Ballou.

Therefore, Claim 5, based on its dependency from Claim 1, is also patentable over the combination of Seidman in view of Brown and further in view of Ballou. Consequently, Applicant respectfully requests that the Examiner reconsider and withdraw the §103(a) rejection of Claim 5.

The Examiner has rejected Claims 9-10 and 31-32 under 35 U.S.C. §103(a) as being unpatentable over Seidman in view of Brown and further in view of Ten Kate and further in view of Ballou. Applicant respectfully traverses this rejection.

Regarding the Examiner's citing of Ten Kate and Ballou, Applicant respectfully submits that the Examiner's citing of Ten Kate and Ballou fail to rectify the deficiencies of the combination of Seidman in view of Brown to teach or suggest the receipt of at least one upcoming data file broadcast by a service provider system and an available for broadcast data file by the broadcast service system, as recited by Claims 6 and 28. Applicant respectfully submits that such references are expressly limited to receipt of broadcast data files from either a single broadcast service system or a service provider system.

Accordingly, Applicant respectfully submits that Claims 6 and 28 are patentable over the combination of Seidman in view of Brown and further in view of Ten Kate and further in view of Ballou.

Consequently, Claims 9 and 10, based on their dependency from Claim 6, and Claims 31 and 32, based on their dependency from Claim 28, are also patentable over the combination of Seidman in view of Brown and further in view of Ten Kate and further in view of Ballou. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the §103(a) rejection of Claims 9, 10, 31 and 32.

The Examiner has rejected Claim 30 under 35 U.S.C. §103(a) as being unpatentable over Seidman in view of Brown and further in view of U.S. No. 6,490,722 issued to Barton et al. ("Barton"). Applicant respectfully traverses this rejection.

Regarding the Examiner's citing of Barton, Applicant respectfully submits that the Examiner's citing of Barton fails to rectify the deficiencies of the combination of Seidman in view of Brown to teach the receipt at least one upcoming data file broadcast by a service provider system and an available for broadcast data file broadcast by the broadcast service system. Consequently, Applicant respectfully submits that Claim 28, as amended, is patentable over the combination of Seidman in view of Brown and further in view of Barton.

Therefore, Claim 30, based on its dependency from Claim 28, is also patentable over the combination of Seidman in view of Brown and further in view of Barton. Consequently, Applicant respectfully requests that the Examiner reconsider and withdraw the §103(a) rejection of Claim 30.

The Examiner has rejected Claim 27 under 35 U.S.C. §103(a) as being unpatentable over Seidman in view of Brown and further in view of U.S. Application No. 2002/0199194 to Ali (“Ali”). Applicant respectfully traverses this rejection.

Regarding the Examiner’s citing of Ali, Ali fails to rectify the deficiencies of the combination of Seidman in view of Brown to teach the modification of Seidman to perform the non-concurrent transmission of audio and video streams, as required to render Claim 25 obvious. As indicated above, the Examiner’s citing of any reference to teach such modification of Seidman would be prohibited since such modification renders Seidman unsatisfactory for its intended purpose. In re Gordon, *supra*. Therefore, Applicant respectfully submits that Claim 25 is patentable over the combination of Seidman in view of Brown and further in view of Ali. *Id.*

Consequently, Claim 27, based on its dependency from Claim 25, is also patentable over the combination of Seidman in view of Brown and further in view of Ali. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the §103(a) rejection of Claim 27.

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CONCLUSION

In view of the foregoing, it is submitted that Claims 1-36 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

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Dated: April 28, 2006

By: _____

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CERTIFICATE OF MAILING:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on April 28, 2006

Marilyn Bass

April 28, 2006